

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Dany Sylvain

Serial No. 10/028,510

Filed: 12/20/2001

For: **COMBINING MULTIMEDIA SERVICES WITH TRADITIONAL TELEPHONY**

Examiner: Tran, Phuc H.

Art Unit: 2616

Mail Stop Appeal Brief – Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

An **APPEAL BRIEF** is filed herewith. Appellant also encloses a payment in the amount of \$950.00 to cover the fees associated with a Two-month Extension of Time and with this appeal brief as required by 37 C.F.R. § 1.17(c). If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

APPEAL BRIEF

(1) REAL PARTY IN INTEREST

The real party in interest is the assignee of record, i.e., Nortel Networks Limited of 2351 Boulevard Alfred-Nobel, St. Laurent, Quebec Canada H4S 2A9, which is wholly owned by Nortel Networks Corporation, a Canadian corporation.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Appellant's knowledge.

(3) STATUS OF CLAIMS

Claims 1-27 were rejected with the rejection made final on March 8, 2006.

Claims 1-27 are pending and are the subject of this appeal.

(4) STATUS OF AMENDMENTS

All amendments have been entered to the best of Appellant's knowledge.

No amendments have been made after the Final Rejection mailed March 8, 2006.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

The present invention provides a combined user agent (CUA) to represent a telephone supported by a circuit-switched telephony switch and a packet-based media device as an integrated group to other network entities. The CUA is configured to facilitate the necessary call signaling to establish and control a voice call via the telephony switch, as well as the session control signaling necessary to establish and control a media session with the media device. Accordingly, the telephone and media device appear to the network devices as a single device having voice and media capabilities, wherein the voice capabilities are controlled in part by the telephony switch (Specification, paragraph 0004).

Although the telephony switch uses circuit-switched communications, the telephone may be a circuit-switched telephone supported by the switch or may be a packet-based telephone, which is supported by a gateway supported by the telephony switch. Further, the call signaling may take any form acceptable by the telephony switch to facilitate call processing and control. For example, the call signaling may conform to an intelligent network protocol and take place in part over an intelligent network primarily dedicated for call signaling (Specification, paragraph 0005). Preferably, the voice call and media session are associated with one another using the CUA, and information about or related to the voice call and media session may be shared with applications participating in the voice call or media session (Specification, paragraph 0006).

Claim 1 recites a system comprising:

an interface adapted to facilitate media communications (such as packet network interface 38, Figure 4; Specification, paragraph 0026); and

a control system (such as control system 36, Figure 4; Specification, paragraph 0026) associated with the interface and providing a combined user agent (CUA 14 and 140, Figures 1-4; Specification, paragraph 0026), which is adapted to:

represent a telephone (such as telephone 22, Figure 1) and a computing device (such as computer 18, Figure 1) as a single multimedia device capable of supporting voice and media sessions (Specification, paragraphs 0004-0006, 0015-0017, 0021, 0022, 0026; see Figures 1-3);

communicate with a circuit-switched telephony switch (such as telephony switch 24, Figure 1) to establish a connection with the telephone through the circuit-switched telephony switch to facilitate a voice session with another voice-capable device

(Specification, paragraphs 0004, 0015, 0017, 0021, 0023, 0025, 0029-0031, and 0033; Figures 4 and 5a-5c); and

communicate with the computing device to establish a media session between the computing device and another media-capable device (Specification, paragraphs 0004, 0015, 0016, 0021, 0024, 0025, and 0032-0034; Figures 4 and 5a-5c),

wherein the combined user agent appears to network devices as a multimedia client supporting voice and media sessions (Specification, paragraphs 0004, 0015, 0017, 0021, 0023, 0024, and 0034, Figures 4 and 5a-5c) and interacts with the circuit-switched telephony switch as well as the computing device to facilitate the voice and media sessions (Specification, paragraphs 0004, 0015, 0017, 0021, 0023, 0025, 0029-0031, 0033, and 0034; Figures 4 and 5a-5c).

Claim 10 recites a method facilitating voice and media sessions comprising:

representing a telephone (such as telephone 22, Figure 1) and a computing device (such as computer 18, Figure 1) as a combined user agent (CUA 14 and 14a, Figures 1-4; Specification, paragraph 0026) capable of supporting voice and media sessions (Specification, paragraphs 0004-0006, 0015-0017, 0021, 0022, and 0026; Figures 1-3);

communicating with a circuit-switched telephony switch (such as telephony switch 24, Figure 1) to establish a connection with the telephone through the circuit-switched telephony switch to facilitate a voice session with another voice-capable device (Specification, paragraphs 0004, 0015, 0017, 0021, 0023, 0025, 0029-0031, and 0033; Figures 4 and 5a-5c); and

communicating with a computing device to establish a media session between the computing device and another media-capable device (Specification, paragraphs 0004, 0015, 0016, 0021, 0024, 0025, and 0032-0034; Figures 4 and 5a-5c),

wherein the combined user agent appears to network devices as a multimedia client supporting voice and media sessions (Specification, paragraphs 0004, 0015, 0017, 0021, 0023, 0024, and 0034; Figures 4 and 5a-5c) and interacts with the circuit-switched telephony switch as well as the computing device to facilitate the voice and media sessions (Specification, paragraphs 0004, 0015, 0017, 0021, 0023, 0025, 0029-0031, 0033 and 0034; Figures 4 and 5a-5c).

Claim 19 recites a computer readable medium having software for implementing a combined user agent and comprising computer instructions to:

represent a telephone (such as telephone 22, Figure 1) and a computing device (such as computer 18, Figure 1) as a single multimedia device capable of supporting voice and media sessions (Specification, paragraphs 0004-0006, 0015-0017, 0021, 0022, and 0026; Figures 1-3);

communicate with a circuit-switched telephony switch (such as telephony switch 24, Figure 1) to establish a connection with the telephone through the circuit-switched telephony switch to facilitate a voice session with another voice-capable device (Specification, paragraphs 0004, 0015, 0017, 0021, 0023, 0025, 0029-0031, and 0033; Figures 4 and 5a-5c); and

communicate with a computing device to establish a media session between the computing device and another media-capable device (Specification, paragraphs 0004, 0015, 0016, 0021, 0024, 0025, and 0032-0034; Figures 4 and 5a-5c),

wherein the combined user agent appears to network devices as a multimedia client supporting voice and media sessions and interacts with the circuit-switched telephony switch as well as the computing device to facilitate the voice and media sessions.

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-6, 9-15, 18-24, and 27 were properly rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,295,293 B1 to Tonnby et al. (hereinafter “Tonnby”).

B. Whether claims 7, 8, 16, 17, 25, and 26 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Tonnby in view of U.S. Patent No. 6,822,957 B1 to Schuster et al. (hereinafter “Schuster”).

(7) ARGUMENT

A. Introduction

Tonnby does not anticipate claims 1-6, 9-15, 18-24 and 27. As an example, claim 1 recites a control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch.” In Tonnby, the element that the Patent Office has equated with the control system is positioned between the telephone and the PSTN. Thus, it is not possible that the control system can establish a connection to the telephone **through** the PSTN (See Tonnby, Figure 4). Since the claim clearly recites that the connection must be established **through** the telephony switch to the

telephone, and Tonnby shows that such an arrangement is not possible, Tonnby cannot anticipate claim 1.

With respect to claims 7, 8, 16, 17, 25, and 36, the Patent Office has not shown where all the elements of the claim are shown with sufficient particularity to sustain an obviousness rejection. The Patent Office is improperly combining the Tonnby and Schuster references using hindsight to reconstruct the claimed invention by using Appellant's disclosure as a template. In particular, the Patent Office has not provided any evidence to prove the motivation to combine the references. Even if Tonnby and Schuster were properly combined, a point Appellant does not concede, the combination does not teach or suggest each and every element of the claims. As explained above, Tonnby does not teach communicating with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch. Nothing in Schuster cures these deficiencies of Tonnby. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element, and the claims are allowable.

For the above reasons, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow claims 1-27.

B. Summary of the References

1. U.S. Patent No. 6,295,293 B1 to Tonnby

Tonnby is directed to a network terminal and an IP based access network. Tonnby is aimed at using IP transport in lieu of the PSTN (see "Technical Field and Background" section of Tonnby). Tonnby is directed to a network terminal and an IP access node in an access network where IP is used as an internal multiplexing and transport technique, thereby allowing data to be transferred at a speed limited only by the modem technique used, and not by the restrictions posed by the PSTN (Abstract). In the invention of Tonnby, there will be an "always on" IP connection between the user's network terminal and the IP access server such that the problem with long duration and low utilization of the available bandwidth of dialed up Internet access over the PSTN is eliminated. According to the invention of Tonnby, the Internet access traffic will not enter the PSTN and the risk of congestion in the PSTN is non-existent (col. 5, lines 26-33). In describing how the access network of Tonnby in Fig. 10 handles the telephony

application, Tonnby teaches that the basic principle is that communication to/from the telephony server 9 and to/from the network terminal 28 is performed by IP (Tonnby, col. 12, lines 3-6).

In Tonnby, the network node provides instant access to a multitude of communication services. In the access network, IP is used as the multiplexing and transport technique. The speed at which data is transported on the access line is limited by the transmission technique used, not by the restrictions posed by the PSTN (Tonnby, col. 1, lines 5-13). The purpose of the invention in Tonnby is to solve the problem with the low utilization of the available bandwidth of the non-concentrated IP traffic in the PSTN, without adapting the PSTN to the characteristics of the Internet access traffic (Tonnby, col. 4, lines 3-7). In accordance with the invention of Tonnby, IP is used as the transport protocol in the access network and the IP access traffic should not use switched PSTN connections (Tonnby, col. 4, lines 18-22).

2. U.S. Patent No. 6,822,957 B1 to Schuster

Schuster relates to providing distributed network address translation for a network telephony system (Schuster, col. 1, lines 15-18). A first telephone using a first protocol requests a locally unique port from a first network device on the same network as the phone (Schuster, Abstract). A combination network address is created for the phone with the locally unique port and a common external network address, thereby identifying the first phone for communications with a second network device on a second network. *Ibid.*

C. Legal Standards

1. The Standards for Establishing Anticipation

Section 102 of the Patent Act provides the statutory basis for an anticipation rejection and states *inter alia*:

A person shall be entitled to a patent unless

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language. . . .

The Federal Circuit's test for anticipation has been set forth numerous times. "It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). This standard has been reinforced. "To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." *PPG Indus. Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1577 (Fed. Cir. 1996) (citations omitted). Further, "a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device." *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998) (emphasis added and citations omitted).

2. The Standards for Establishing Obviousness

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Courts have interpreted 35 U.S.C. § 103(a) as a question of law based on underlying facts. As the Federal Circuit stated:

Obviousness is ultimately a determination of law based on underlying determinations of fact. These underlying factual determinations include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness.

Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 45 U.S.P.Q.2d (BNA) 1977, 1981 (Fed. Cir. 1998) (internal citations omitted).

Once the scope of the prior art is ascertained, the content of the prior art must be properly combined. Initially, the Patent Office must show that there is a suggestion to combine the references. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). Even if the Patent Office is able to articulate and support a suggestion to combine the references, it is impermissible to pick and choose elements from the prior art while using the application as a template. *In re Fine*, 837

F.3d 1071 (Fed. Cir. 1988). To reconstruct the invention by such selective extraction constitutes impermissible hindsight. *In re Gorman*, 933 F.2d 982 (Fed. Cir. 1991). After the combination has been made, for a *prima facie* case of obviousness, the combination must still teach or fairly suggest all of the claim elements. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974); MPEP § 2143.03.

While the Patent Office is entitled to give claim terms their broadest reasonable interpretation, this interpretation is limited by a number of factors. First, the interpretation must be consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); MPEP § 2111. Second, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, (Fed. Cir. 1999); MPEP § 2111. Finally, the interpretation must be reasonable. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004); MPEP § 2111.01. This means that the words of the claim must be given their plain meaning unless Appellant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

If a claim element is missing after the combination is made, then the combination does not render obvious the claimed invention, and the claims are allowable. As stated by the Federal Circuit, “[if] the PTO fails to meet this burden, then the Appellant is entitled to the patent.” *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

D. Claims 1-6, 9-15, 18-24, and 27 Are Not Anticipated Because Tonnby Fails to Teach Communicating With a Circuit-Switched Telephony Switch to Establish a Connection with the Telephone Through the Circuit-Switched Telephony Switch

Claims 1-6, 9-15, 18-24, and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Tonnby. For the Patent Office to prove anticipation, the Patent Office must show where each and every element of the claim is shown in the reference. Furthermore, the elements of the reference must be arranged as claimed. MPEP § 2131.

The present invention is designed to provide a combined user agent (CUA) to act as an effective proxy for a telephone and multimedia device so that a network would perceive the two elements as a single device. The CUA, however, has a telephony switch between the combined user agent and the telephone (see Figures 1-4, wherein the CUA 14 has switch 24 between the CUA 14 and the telephone 22). Thus, to establish a connection with the telephone, the CUA has to make the connection through the telephony switch. In particular, claim 1 recites the control

system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch . . .” (emphasis added).

In contrast, Tonnby is really directed to a different invention. Tonnby is aimed at using IP transport in lieu of the PSTN (see “Technical Field and Background” section of Tonnby). Tonnby is directed to a network terminal and an IP access node in an access network where IP is used as an internal multiplexing and transport technique, thereby allowing data to be transferred at a speed limited only by the modem technique used, and not by the restrictions posed by the PSTN (Abstract). In the invention of Tonnby, there will be an “always on” IP connection between the user’s network terminal and the IP access server such that the problem with long duration and low utilization of the available bandwidth of dialed up Internet access over the PSTN is eliminated. According to the invention of Tonnby, the Internet access traffic will not enter the PSTN and the risk of congestion in the PSTN is non-existent (col. 5, lines 26-33). In describing how the access network of Tonnby in Fig. 10 handles the telephony application, Tonnby teaches that the basic principle is that communication to/from the telephony server 9 and to/from the network terminal 28 is performed by IP (Tonnby, col. 12, lines 3-6).

Claim 1 recites the control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch . . .” (emphasis added). Tonnby fails to teach this element and thus cannot anticipate claim 1. The Patent Office asserts that the control system is Tonnby’s element 24, the telephone is element 5 of Figure 4 of Tonnby, and that the telephone coupled with the PSTN 2 of Figure 4 shows this element (Office Action mailed September 19, 2005, p. 3; see also Advisory Action mailed July 11, 2006, p. 2). However, the arrangement of Figure 4 in Tonnby does not correspond to the claim language. That is, the claim requires that the connection be established **through** the telephony switch to the telephone. In contrast, element 24 is positioned between the telephone 5 and the PSTN 2 in Figure 4. Thus, it is not possible that the control system can establish a connection to the telephone 5 **through** the PSTN 2. Since the claim clearly recites that the connection must be established **through** the telephony switch to the telephone, and the reference shows that such an arrangement is not possible, Tonnby cannot anticipate claim 1.

In the Final Office Action, the Patent Office responded by stating that columns 7 and 8 of Tonnby “teaches how the connection between the telephone and the PSTN through the telephony

server and Fig. 10 also teaches the telephone 5 communicate with PSTN 2. Therefore, the connection between the telephone and the PSTN through the switch can be established.” (Final Office Action mailed March 8, 2006, p. 5). Appellant respectfully disagrees. Columns 7 and 8 of Tonnby provide no teaching of a control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch,” as required by claim 1.

Column 7, lines 19-31 describes Figure 4 and discloses how an incoming call is received by the PSTN interface of the telephony server, where the telephony server digitizes and packetizes the incoming speech, provides it with a call identifier, puts it into IP packets, and provides the IP packets with the internal IP address of the network terminal and the port number of the telephony application in Fig. 10. This section of Tonnby discloses how the telephony server handles a call received at the PSTN interface of the telephony server; it does not teach a control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch,” as required by claim 1. The telephony server of Tonnby is not a circuit-switched telephony switch (see col. 9, lines 2-13 and col. 11, line 60 through col. 12, line 6, describing the telephony server).

Column 7, lines 32-50 of Tonnby describes how control signaling associated with the incoming call is described in Fig. 10. This whole section is directed to handling incoming IP traffic; the only mention of the PSTN is discussing if there is an incoming call from the PSTN simultaneously with incoming IP packets from the Internet. There is no mention of a control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch,” as required by claim 1.

Column 7, lines 54-63 of Tonnby describes control signaling for outgoing traffic. Once again, this passage is concerned with the network terminal converting speech to IP packets, wherein the IP packets are ultimately sent to the telephony server where they are depacketized and subjected to a D/A conversion. The result is an analog signal that is sent to the PSTN. However, there is no teaching of a control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch,” as required by claim 1.

The element of Tonnby that connects to the PSTN is the telephony server. Even Fig. 10, which was cited by the Examiner, shows that the telephone 5 communicates with the PSTN through the telephony server (see also col. 7, lines 32-50, which describes Fig. 10), and not “**through** the circuit-switched telephony switch,” as required by claim 1. In describing how the access network in Fig. 10 handles the telephony application, Tonnby teaches that the basic principle is that communication to/from the telephony server 9 and to/from the network terminal 28 is performed by IP (Tonnby, col. 12, lines 3-6). Thus, telephony communication in Tonnby is not done **through** the circuit-switched telephony switch. Accordingly, Tonnby does not anticipate claim 1.

Since Tonnby does not teach the claimed element of a control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch,” as required by claim 1, it cannot anticipate claim 1. This is not surprising considering that the teachings of Tonnby are really directed to a different invention; i.e., using IP transport in lieu of the PSTN such that traffic is not routed over the PSTN. Given that Tonnby handles the telephony application by teaching that communication to/from the telephony server 9 and to/from the network terminal 28 is performed by IP (Tonnby, col. 12, lines 3-6), it follows that Tonnby does not teach a control system adapted to “communicate with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch.”

Claims 2-6 and 9 depend from claim 1 and are not anticipated at least for the same reasons.

Claim 10 recites essentially the same element, albeit in method form. As such, claim 10 is not anticipated. Claims 11-15 and 18 depend from claim 10 and are not anticipated at least for the same reasons.

Claim 19 recites essentially the same element, albeit in a software format. As such, claim 19 is not anticipated. Claims 20-24 and 27 depend from claim 19 and are not anticipated at least for the same reasons.

E. Claims 7, 8, 16, 17, 25, and 26 Are Non-Obvious

The Patent Office has rejected claims 7, 8, 16, 17, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Tonnby in view of Schuster. For the Patent Office to combine

references in an obviousness rejection, the Patent Office must prove that there is a suggestion to combine the references. To prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Even if the combination is proper, to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination. MPEP § 2143.03.

1. The Combination of Tonnby and Schuster Is Improper Because the Patent Office Has Not Provided Any Actual Evidence to Support the Stated Motivation to Combine the References

The proposed combination of Tonnby and Schuster is improper because the Patent Office has not properly supported the motivation to combine the references. In particular, the Patent Office asserts that the motivation is “to implement the session initiation protocol for setup communication in the network.” (Final Office Action mailed March 8, 2006, p.5). However, the Patent Office provides no actual evidence to support the stated motivation. Thus, the asserted motivation lacks the requisite evidence. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). Since the motivation lacks the required evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the Patent Office has not established obviousness, and the claims are allowable.

2. The Combination of Tonnby and Schuster Fails to Teach that the Control System Is Adapted to “Communicate With a Circuit-Switched Telephony Switch to Establish a Connection with the Telephone Through the Circuit-Switched Telephony Switch”

Even if the combination of Tonnby and Schuster is proper, a point Appellant does not concede, the combination does not teach or suggest each and every element of claims 7, 8, 16, 17, 25, and 26. Claims 7 and 8 depend from claim 1. Claims 16 and 17 depend from claim 10. Claims 25-26 depend from claim 19. Thus, each of these dependent claims also has communicating with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch as a claim element. As explained above, Tonnby does not teach that the connection is made through the telephony switch to the

telephone. Nothing in Schuster cures these deficiencies of Tonnby. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness. Since the combination does not establish obviousness, the claims are allowable.

F. Conclusion

The claims of the present invention require communication with a circuit-switched telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch. Tonnby fails to teach this claim limitation, and therefore does not anticipate the claimed invention. Schuster does not cure the deficiencies of Tonnby in this regard. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness. Since the combination does not establish obviousness, the claims are allowable. In addition, the proposed combination of Tonnby and Schuster is improper because the Patent Office has failed to properly support the motivation to combine the references by providing actual evidence to support the stated motivation.

For the above stated reasons, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow claims 1-27.

Respectfully submitted,

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(8) APPENDIX

1. A system comprising:
 - a) an interface adapted to facilitate media communications; and
 - b) a control system associated with the interface and providing a combined user agent, which is adapted to:
 - i) represent a telephone and a computing device as a single multimedia device capable of supporting voice and media sessions;
 - ii) communicate with a circuit-switched telephony switch to establish a connection with the telephone through the circuit-switched telephony switch to facilitate a voice session with another voice-capable device; and
 - iii) communicate with the computing device to establish a media session between the computing device and another media-capable device,wherein the combined user agent appears to network devices as a multimedia client supporting voice and media sessions and interacts with the circuit-switched telephony switch as well as the computing device to facilitate the voice and media sessions.
2. The system of claim 1 wherein the combined user agent is further adapted to associate the connection and media session with one another.
3. The system of claim 1 wherein the combined user agent is further adapted to provide information associated with the connection to the computing device for use in an application associated with the media session.
4. The system of claim 1 wherein the combined user agent is further adapted to communicate with the circuit-switched telephony switch using call signaling messages required to establish and control the connection between the telephone and the voice-capable device.
5. The system of claim 4 wherein the combined user agent is further adapted to communicate with the circuit-switched telephony switch using a first protocol.

6. The system of claim 5 wherein the combined user agent is further adapted to communicate with the computing device with signaling messages required to establish and control a media session between the computing device and the media-capable device using a second protocol.
7. The system of claim 1 wherein the combined user agent is further adapted to use the session initiation protocol, SIP, when representing the multimedia device to other SIP devices.
8. The system of claim 7 wherein the combined user agent is further adapted to use the session initiation protocol when communicating with the computing device to establish the media session between the computing device and another media-capable device.
9. The system of claim 1 wherein the media session established between the computing device and another media capable device is at least one of the group consisting of video session, screen sharing session, audio streaming, video streaming, information streaming, voicemail, email, gaming, advertising, and instant messaging session.
10. A method facilitating voice and media sessions comprising:
 - a) representing a telephone and a computing device as a combined user agent capable of supporting voice and media sessions;
 - b) communicating with a circuit-switched telephony switch to establish a connection with the telephone through the circuit-switched telephony switch to facilitate a voice session with another voice-capable device; and
 - c) communicating with a computing device to establish a media session between the computing device and another media-capable device,wherein the combined user agent appears to network devices as a multimedia client supporting voice and media sessions and interacts with the circuit-switched telephony switch as well as the computing device to facilitate the voice and media sessions.
11. The method of claim 10 further comprising associating the connection and media session with one another.

12. The method of claim 10 further comprising providing information associated with the connection to the computing device for use in an application associated with the media session.

13. The method of claim 10 further comprising communicating with the circuit-switched telephony switch using call signaling messages required to establish and control the connection between the telephone and the voice-capable device.

14. The method of claim 13 further comprising communicating with the circuit-switched telephony switch using a first protocol.

15. The method of claim 14 further comprising communicating with the computing device with signaling messages required to establish and control a media session between the computing device and the media-capable device using a second protocol.

16. The method of claim 10 further comprising communicating using the session initiation protocol, SIP, when representing the multimedia device to other SIP devices.

17. The method of claim 16 further comprising communicating using the session initiation protocol when communicating with the computing device to establish the media session between the computing device and another media-capable device.

18. The method of claim 10 wherein the media session established between the computing device and another media-capable device is at least one of the group consisting of video session, screen sharing session, audio streaming, video streaming, information streaming, voicemail, email, gaming, advertising, and instant messaging session.

19. A computer readable medium having software for implementing a combined user agent and comprising computer instructions to:

a) represent a telephone and a computing device as a single multimedia device capable of supporting voice and media sessions;

b) communicate with a circuit-switched telephony switch to establish a connection with the telephone through the circuit-switched telephony switch to facilitate a voice session with another voice-capable device; and

c) communicate with a computing device to establish a media session between the computing device and another media-capable device,

wherein the combined user agent appears to network devices as a multimedia client supporting voice and media sessions and interacts with the circuit-switched telephony switch as well as the computing device to facilitate the voice and media sessions.

20. The computer readable medium of claim 19 wherein the instructions are further adapted to associate the connection and media session with one another.

21. The computer readable medium of claim 19 wherein the instructions are further adapted to provide information associated with the connection to the computing device for use in an application associated with the media session.

22. The computer readable medium of claim 19 wherein the instructions are further adapted to communicate with the circuit-switched telephony switch using call signaling messages required to establish and control the connection between the telephone and the voice-capable device.

23. The computer readable medium of claim 22 wherein the instructions are further adapted to communicate with the circuit-switched telephony switch using a first protocol.

24. The computer readable medium of claim 23 wherein the instructions are further adapted to communicate with the computing device with signaling messages required to establish and control a media session between the computing device and the media-capable device using a second protocol.

25. The computer readable medium of claim 19 wherein the instructions are further adapted to use the session initiation protocol, SIP, when representing the multimedia device to other SIP devices.

26. The computer readable medium of claim 25 wherein the instructions are further adapted to use the session initiation protocol when communicating with the computing device to establish the media session between the computing device and another media capable device.

27. The computer readable medium of claim 19 wherein the media session established between the computing device and another media capable device is at least one of the group consisting of video session, screen sharing session, audio streaming, video streaming, information streaming, voicemail, email, gaming, advertising, and instant messaging session.

(9) EVIDENCE APPENDIX

Appellant relies on no evidence, thus this appendix is not applicable.

(10) RELATED PROCEEDINGS APPENDIX

As there are no related proceedings, this appendix is not applicable.